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09/897,333

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

ANDREOLI, Rita et al.

Serial No.: 09/897,333

Filing Date: July 2, 2001

Title: NON-LUMINESCENT SUBSTRATE

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) Examiner: J. Snay
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) Group Art Unit: 1743
) Confirmation No.: 2090
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Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Office Action dated June 25, 2004 setting forth a restriction requirement, please enter the following remarks:

REMARKS

Claims 1-62 are pending in the present application and are subject to a restriction requirement. In particular, the Examiner has indicated that the application contains claims directed to the following inventions:

- I. Claims 1-25, 41-57 and 61-62, drawn to an optical substrate, classified in class 356, subclass 244;
- II. Claims 26-33, drawn to a fluorometric assay method, classified in class 436, subclass 172;
- III. Claims 34-40 and 58-60, drawn to a method for manufacturing a substrate, classified in class 264, subclass 41.

In the outstanding Office Action, the Examiner explained that the inventions are distinct from each other because of the following reasons. The Examiner found that Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. (MPEP § 806.05(h)) In the instant case, the Examiner found that the product could be used for a number of materially different uses, including optical lenses and filters. As a result, the Examiner concluded that Inventions I and II are unrelated.

Also, the Examiner found that Inventions III and I are related as process of making and product made. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process as claimed can be used to make other and materially different product or (2) the product as claimed can be made by another and materially different process of using. (MPEP § 806.05(f)) In the instant case, the Examiner found that the product could be made by a materially different process, such as molding or coating. As a result, the Examiner concluded that Inventions III and I are unrelated.

Further, the Examiner found that Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and have different modes of operation, different functions, or different effects. (MPEP § 806.04, MPEP§ 808.01) In the instant case, the Examiner found that Inventions II and III have different functions. Invention II operates to fluorometrically detect an analyte whereas method III operates to form an article of manufacture. Furthermore, the method of invention II does not require use of the manufacture of method III.

Thus, because the inventions were found to be distinct for the reasons given above and having acquired a separate status in the art, as shown by their different classification, restriction for examination purposes was determined to be proper by the Examiner.

Accordingly, in response to the Restriction Requirement, Applicants hereby elect the invention of Group I defined by claims 1-25, 41-57 and 61-62, drawn to an optical substrate. Applicants reserve the right to elect and prosecute the non-elected claim in a co-pending application to be filed at a later date.

Based upon the foregoing, early and favorable consideration of claims 1-25, 41-57 and 61-62 is respectfully requested.

Date: 7-19-04

Respectfully submitted,



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• CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

Date

7-19-2004

Mary Rudaitis

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